

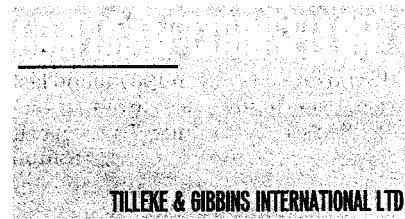
# APPRECIATING THE SUSTAINABILITY OF WELL-KNOWN TRADEMARKS

A trademark is more than just a name that distinguishes one product from another. A brand can also signify value and trustworthiness (or sometimes a bad reputation), and can be worth billions of dollars. While building a publicly recognised brand such as Pepsi, Red Bull, Honda or McDonald's requires a great effort, protecting a brand's well-known status also involves serious diligence. Preventing imitative and counterfeit products from entering the market is crucial to sustaining a brand.

A brand owner's very first task in protecting his or her intellectual property rights in the trademark is to register the mark with the authorities of each country where the concerned products are or will be sold. Some laid-back trademark owners may trust that registering their trademarks guarantees full protection for the mark until the registration expires, which is not always the case. Brand owners must also consider whether an assertive legal approach is necessary.

In theory, a registrant has the exclusive rights to use his or her trademarks in Thailand for the claimed products or services, and the registration bars registrations of confusingly similar trademarks filed by third parties. However, sometimes a trademark similar to a prior-registered trademark manages to register after being published for opposition in the Thai *Trademark Gazette*.

Cancellation of the already-registered



similar mark then becomes the sole option to prevent dilution of one's trademark. Since cancelling a registered trademark may be costly, time-consuming and potentially fruitless, brand owners would be wise to take a proactive approach and file oppositions to similar marks. Even though coexistence of similar trademarks may not always cause public confusion, the potential dilution caused by the registration and use of similar trademarks and the subsequent detriment to hard-earned brand values and sustainability requires vigilance on a brand owner's behalf.

Filing an opposition to a trademark application presents a more cost-effective and timely solution than attempting to cancel registered trademarks. Any interested person is eligible to file an opposition against a trademark application published in the *Trademark Gazette*, and a trademark lawyer can assist with writing the opposition. However, one needs to know in advance which trademarks should be opposed by periodically watching the *Trademark Gazette* to see if any published trademarks

look similar to one's own. Failure to file an opposition within the 90-day timeline may result in registration of a third party's similar trademark, which could cause public confusion about the origin of the respective goods and possibly dilute one's brand.

Another possible threat to a brand's sustainability is when it becomes popular enough to catch on as a verb or a noun, such as "to Xerox a document" (whether or not the copier used is a Xerox) or "to wipe your nose with a Kleenex" (whether or not the tissue is a Kleenex). While the genericisation of Xerox and Kleenex helped to build up brand recognition, it has also hurt these companies' ability to enforce their rights when infringed, and has cost them licensing revenue.

In order to protect against such brand dilution and to safeguard against a genericised registered trademark being revoked for lack of distinctiveness, the symbols TM (for unregistered trademarks) or ® (for registered trademarks) should always be used next to the brand to help remind the public that the mark is protected and is not simply a colloquial term available for exploitation in any manner. Documentation of consistent use of TM and ® with one's marks is also likely to convince a court that a company has been steadfast in sustaining the mark's legally protected status. However, documented reminders of protected status are not enough to sustain a brand. Monitoring the marketplace for

unauthorised use of one's trademark by infringers is also crucial.

In a landmark case in China, a US auto and auto parts manufacturer was successfully pled into a case as a co-defendant in a product liability action against a manufacturer of counterfeit auto parts. The manufacturer's joinder into the action was appealed up to China's Supreme People's Court, which ultimately held that the manufacturer could be so joined, thereby establishing the concept of IP owner liability for counterfeit products causing harm. To prevent being liable for harm to consumers and to preserve the good reputation of their marks, brand owners must be careful both to scrutinise the market for fake goods bearing their marks and to pursue legal action against any infringement discovered. Thailand's recently enacted Product Liability Act should spur brand owners to increase their vigilance in market monitoring and prosecution against infringers.

The effort to sustain a trademark's fame, maintain its values and avoid dilution may seem a costly and time-intensive burden at times, but will result in tremendous returns if managed wisely by brand owners cognisant of the effort's necessity.

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